

REMARKS

Claims 3-19 and 20-23 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein. Claim 19 has been amended to change “magnet” to “electromagnet” for clarity.

REJECTION UNDER 35 U.S.C. § 103

Claims 3-19 and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Creighton, IV et al.* (U.S. Pat. No. 6,529,761). This rejection is respectfully traversed.

The Office Action asserts that the system in *Creighton, IV et al.* has at least three or more magnets which are configured and arranged on a support that is not planar. The Office Action further alleges that it would have been obvious to provide a planar support rather than an arcuate structure, as long as there was space between the magnets to allow imaging to occur unobstructed. However, neither *Creighton, IV et al.* nor the Office Action provide any motivation or support as to why a planar structure would have been obvious in the present claims.

Creighton, IV et al. discloses a moveable support having a row of electromagnetic coils, which can be energized in any position to provide the needed direction of magnetic field. (*Creighton, IV et al.*, column 6 lines 39 and 48-49). As the Office Action concedes, *Creighton, IV et al.* does not suggest arranging three or more magnets on a planar support. While *Creighton, IV et al.* does not “expressly teach a planar support”. *Creighton, IV et al.* does state that “any moveable support means may be provided, and alternate structures for providing pivoting or rotational movement of

the supporting means may be provided". (*Creighton, IV et al.*, column 6 lines 61-63). At most this means that *Creighton, IV et al.* does not exclude the possibility of a planar support, it does not, however, mean that *Creighton, IV et al.* teaches or suggests the required planer support. The only support shown or described in *Creighton, IV et al.* is an arcuate support, which is important because in at least most of the embodiments, the magnets were intended to move about the patient.

The planar arrangement has a number of distinct advantages. As shown in Fig. 47, the arrangement of magnets on planar support 416 allows for positioning a patient in an opening 422 of a compact CT imaging device that is not significantly affected by the proximity of the magnets (Specification, paragraph [0142]). This particular arrangement of electromagnets on a planar support provides the advantage of accommodating an imaging device having an opening 422 through which a patient can extend "to allow the surgeon to bring virtually any portion of the patient within the operating region of magnet assembly 404 ((Specification, paragraph [0142])).

Obviousness cannot be established without also providing evidence of the motivating force which would impel one skilled in the art to do what the applicants have done. See, *MPEP 2144*. Thus, the Applicant submits that claims 3-19 and 21-22 are not obvious from *Creighton, IV et al.*, and thus are patentable over *Creighton, IV et al.*

NEW CLAIMS

Applicants have added claim 23 depending from independent claim 19, which applicants believe to be allowable in view of the above remarks. Applicants also believe claim 23 is allowable in view of the added feature of the patient support being movable and rotatable to facilitate positioning of the patient relative to the operating region of the

electromagnets, where the magnetic field in an operating region that is sufficient to navigate a magnetic medical device in the portion of a patient that is within the operating region. As such, Applicant submits that claim 23 is allowable in view of the above remarks and by virtue of its dependence from claim 19.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, and that the claims are in a condition for allowance. There is admittedly no express teaching of a planar support in *Creighton, IV et al.*, and applicant submits that there is no teaching or suggestion of a planer support in *Creighton, IV et al.* Applicant therefore respectfully requests that the Examiner allow the application, or at least withdraw the finality of the outstanding rejections made in the Final Office Action. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 726-7500.

Respectfully submitted,

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